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09/780,443	02/12/2001	Yasuhisa Fujiwara	107943	8209

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,443

Applicant(s)

FUJIWARA, YASUHISA

Examiner

CUONG H. NGUYEN

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My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 11,22,25,29 and 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,12-21,23,24,26-28,30 and 36-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This Office Action is the answer to the amendment filed on 3/29/2004; which paper has been placed of record.

2. Claims 1-35 were pending in this application. Claims 11, 22, 25, 29, 31-35 were canceled, new claims 36-51 are added.

Priority

3. This application has a priority date of 2/25/2000 from an JPO patent (JPO 2000-049684).

Response to the amendment:

4. The submitted arguments on 3/29/2004 are unpersuasive since pending claims 1, and 22 are amended to include a limitation of claim 11/22 (i.e., Hartman teaches one of the product selection information and the product delivery information may include encrypted, secure information about the user, and the other of the product selection information and the product delivery information does not include the encrypted, secure information about the user (encrypting sensitive user information; see **Hartman**, 2:5-10); Hartman also suggests that the lesser the better with revealing sensitive information while transmitting product selection information or product delivery information.

On page 16, para.1 of the "REMARKS", the applicant argues about non-functional descriptive material, i.e., in

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"system" claim 27, the "pick-up order list" is taught by Hartman, it is obvious to one of ordinary skill in the art to have different things in that list (i.e., non-functional descriptive material), claiming that "the pick-up order defines ..." and "the pick-up order being determined ..." would not change claimed system's components.

Claim 27 is a method claim; however, a concept of picking-up goods from a shipper based on location was taught by Wojcik et al. (USP 5,666,493).

In summary, this amendment still does not make pending claims avoid obvious rejections. The examiner maintains old references for rejections, and giving rationales and references for amended claims herein; the arguments are moot because new grounds of rejection are applied for amended claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-10, 12-21, 36, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al (USP 5,960,411), hereinafter as Hartman.

A. As to claims 1, 12, 36, 42, 48-51: Hartman teaches a method and a system for placing a purchase order via a communications network. Hartman teaches the claimed electronic commerce system for effecting electronic commercial transactions using a computer network in which computers are interconnected, the system comprising: means for identifying a user and generating user information in response to an access from a user terminal (obtain purchaser ID/info; see **Hartman**, server 210; Fig. 3 step 301; 3:35-55); means for receiving a product purchase request from the user terminal (get purchase order; see **Hartman**, server 210; 3:55-67; 4:10-20); means for creating product selection information for use by a first party that carries products, the product selection information for selection of at least one product, the product selection information is created on the basis of at least one of the product purchase request and the user information (order list; see **Hartman**, Fig. 1A; 5:8-15); and means for creating product delivery information for use by a second party that delivers products, the product delivery information for delivery of the at least one product, the product delivery information is created on

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the basis of at least one of the product purchase request and the user information (shipping information; see **Hartman**, 4:40-58, and 7:25-55).

Although Hartman does not expressly disclose that product selection information and product delivery information do not include user's sensitive information. Hartman suggests that one of the product selection information and the product delivery information may includes encrypted, secure information about the user, and the other of the product selection information and the product delivery information does not include the encrypted, secure information about the user (encrypting sensitive user information; see **Hartman**, 2:5-10 - and Hartman encourages that "it would be desirable to minimize the sensitive information transmitted when placing an order" to ensure the security of the sensitive information not being intercepted (see **Harman**, 2:12-16, 46-48; 4:1-3, and 4:39-58).

It would have been obvious to one of ordinary skills in the art to recognize the suggestions of Hartman that there is no need for sensitive information to be transmitted together with product selection information or with product delivery information to reduce the chances of sensitive information being intercepted; again, artisans would

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recognize that only necessary information for product selection and delivery business are transmitted.

B. As to claims 2, 13: The rationales and reference for rejection of claim 1 are incorporated.

Hartman teaches the product purchase request comprises a request for two or more products, the means for creating product selection information causes the transmitted product selection information to include a product list of at least one of the two or more products that can be packed in a single package (combine multiple orders in one shipment - see **Hartman**, 5:26-35; and 7:25-55).

C. As to claims 3, 4, 14, 15: The rationales and reference for rejection of claim 1 are incorporated.

Hartman teaches the product list of the at least one of the two or more products that can be packed in a single package is produced by the means for creating product selection information on the basis of at least one of a weight and a volume of each of the products contained in the product purchase request (combine shipment based on size; see **Hartman**, 7:35-40).

D. As to claims 6, 17: The rationales and reference for rejection of claim 1 are incorporated.

Hartman teaches means for transmitting information pertaining to the at least one of the two or more products

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that can be packed in a single package, to the user terminal (see **Hartman**, server 210; 7:40-50).

E. As to claims 7, 18: The rationales and reference for rejection of claim 1 are incorporated.

Hartman teaches a first party that carries products is a general shop that carries a plurality of types of products (shop to provide for a variety of products; see **Hartman**, 1:45-50).

F. As to claims 8, 19: The rationales and reference for rejection of claim 1 are incorporated.

Hartman teaches the means for creating product delivery information causes the product delivery information to include a delivery order in which the products are to be delivered (provide shipping date information; see **Hartman**, 5:40-55, 7:40-55, and Fig. 5).

G. As to claims 9, 12, 20, 23, 27:

Hartman teaches means for permitting the user terminal to acquire at least one of a product selection status observed at the first party, and a delivery status observed at the second party (provide product order information/status and shipping status; see **Hartman**, 6:1-5).

Hartman teaches one of the product selection information and the product delivery information includes encrypted, secure information about the user, and the other

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of the product selection information and the product delivery information does not include the encrypted, secure information about the user (encrypting sensitive user information; see **Hartman**, 2:5-10).

Hartman does not specifically teach means for creating the product selection information causes the product selection information to include a pick-up order in which the products are picked up, the pick-up order being determined on the basis of locations of the respective products in the first party.

However, it is well-known in the art that on-line merchants provide many methods of delivery (by shipping through a third party or pick-up by customer at a local distributor/store location) to provide convenience and possible cost-savings to the consumers.

It would have been obvious to one of ordinary skills in the art to provide for the pick-up option of the purchased merchandise at a local distributor/store, in the invention of Hartman, to provide convenience and cost-savings to the consumer.

H. As to claims 10, 21: The rationales and reference for rejection of claim 1 are incorporated.

Hartman teaches means for providing the user terminal with product information in response to a search request

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from the user terminal (see **Hartman**, server 210; provide product description; 4:15-30).

I. As to claims 5, 16: The rationales and reference for rejection of claim 1 are incorporated.

Hartman does not specifically teach means for creating the product selection information causes the product selection information to include a pick-up order in which the products are picked up, the pick-up order being determined on the basis of locations of the respective products in the first party.

However, it is well-known in the art that on-line merchants provide many methods of delivery (by shipping through a third party or pick-up by customer at a local distributor/store location) to provide convenience and possible cost-savings to the consumers.

It would have been obvious to one of ordinary skills in the art to provide for the pick-up option of the purchased merchandise at a local distributor/store, in the invention of Hartman, to provide convenience and cost-savings to the consumer.

J. As to claims 37-41, 43-47:

On page 14, para.3 of the "REMARKS", the applicant admits that newly added dependent claims 37-41 and 43-47 are similar to original dependent claims 5, 7-10, 16 and 18-21,

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respectively; therefore, the same rationales and references set forth for rejections of claims 5, 7-10, 16 and 18-21, are repeated herein.

6. Claims 23-24, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al (USP 5,960,411), hereinafter as Hartman, in view of Wojcik et al. (USP 5,666,493).

A. As to claims 23, 27: Hartman et al. teach a method and a system comprising steps/means for as analyzed in claim 1:

- receiving a purchase request for at least one product from a user terminal; determining whether the purchase request is for more than one product; when the user request is determined to be for more than one product, creating the product list; transmitting the product list to a terminal of the shipper of the products.

Or:

- means for receiving a purchase request for at least one product from a user at a user terminal; and means for creating a product list when the received purchase request is for more than one product package (a product list of the requested products).

Hartman et al. do not teach a step/means including a pick-up order which defines an order in which the requested

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products for a single delivery are to be picked-up from a supplier of the products by a shipper of the products the pick-up order being determined on the basis of locations of the requested products at the supplier of the products.

However, Wojcik et al. suggest that in picking up items based on date rules and location requirements (see **Wojcik et al.**, 17:41-67).

It would have been obvious to one of ordinary skills in the art to combine Hartman and Wojcik et al. to provide a better pick-up option of purchased merchandises based on locations of a supplier/distributor/store, to provide convenience and cost-savings to both the deliver and the consumer.

B. As to claims 24, 28: The rationales and references for rejection of claim 23 are incorporated.

Hartman also teaches the product list of the at least one of the two or more products that can be packed in a single package is produced by the means for creating product selection information on the basis of at least one of a weight and a volume of each of the products contained in the product purchase request (combine shipment based on size; see **Hartman**, 7:35-40).

7. Claims 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al (USP 5,960,411),

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hereinafter as Hartman, in view of Wojcik et al. (USP 5,666,493), further in view of Rodriguez et al. (USP 6,650,761).

The rationales and reference for rejection of claim 23/27 are incorporated.

Hartman and Wojcik et al., do not specifically teach that the supplier of the products and the shipper of the products are the same party.

However, it is old and well-known in the art that an on-line greeting-cards provider and deliver party are the same party (i.e., see Rogriguez et al., 10:29-42).

It would have been obvious to one of ordinary skills in the art to combine Hartman, Wojcik et al., and Rodriguez et al. in selecting both a supplier and a delivering party as the same party (e.g., Hallmark.com) to provide conveniences and cost-savings to the consumer.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see the attached PTO-892).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in

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37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

CUAN
CUONG H. NGUYEN
Primary Examiner
Art Unit 3625